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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/934,016	08/20/2001	David Scott Gray	PGRAC T	7568

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EXAMINER

PATEL, MITAL B

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 02/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/934,016

Applicant(s)

GRAY, DAVID SCOTT

Examiner

Mital B. Patel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

1. It was not executed in accordance with either 37 CFR 1.66 or 1.68. The Applicant signed the Declaration but did not date the Declaration as to when it was signed.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
4. In Claim 1, the Applicant is required to clarify to what the claim is intended to be drawn to, i.e., either the medical port alone or the combination of the medical port and the resuscitator having a collapsible bag. The Applicant sets forth the combination of the medical port and the collapsible bag when describing the "tube having a first aperture attached to and communicating with a second end of a collapsible bag of a resuscitator", which is inconsistent with the preamble, that sets forth the subcombination of a medical port for an emergency safety resuscitator having a collapsible bag. Applicant is required to make the language of the claims consistent with the intent of the claims. It should also be noted that in considering the claims on the merits, the Examiner will consider the claims as drawn to the combination.
5. There is a lack of antecedent basis for the following limitations:

- Claim 1, line 5, "the second end"
- Claim 3, lines 3-4, "the inside"
- Claim 10, lines 3-4, "the inside"

Correction is required.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Wilson (US 4106502).

8. **As to claim 1**, Wilson teaches a medical port for an emergency safety resuscitator having a collapsible bag **50** with an outlet, which comprises an adapter **53** having a first end available for attachment to and communication with a collapsible bag of a resuscitator and also having a second end (**See Fig. 7**); a tube **2** having a first aperture **14** attached to and communicating with a second end of a collapsible bag of a resuscitator, a second aperture **42**, and a third aperture (**See Fig. 1**) available for connection to a mask or an endotracheal tube.

9. **As to claim 12**, Wilson teaches a medical port wherein the adapter and tube are constructed of rigid clear plastic (**See Col. 1, lines 50-54**).

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent

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granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1 and 2 are rejected under 35 U.S.C. 102(e) as being anticipated by Coates et al (US 5762063).

11. **As to claim 1**, Coates teaches a medical port for an emergency safety resuscitator having a collapsible bag **22** with an outlet, which comprises an adapter (the end connected to element **28**) having a first end available for attachment to and communication with a collapsible bag of a resuscitator and also having a second end (**See Fig. 1, second end connects to 28**); a tube **28** having a first aperture attached to and communicating with a second end of a collapsible bag of a resuscitator, a second aperture **12**, and a third aperture **14** available for connection to a mask or an endotracheal tube.

12. **As to claim 2**, Coates teaches a medical port further comprising a self-sealing membrane releasably covering the second aperture of the tube (**See Col. 5, lines 19-50, specifically lines 40-42**).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Wilson (US 4103502).

15. **As to claim 7**, Coates teaches essentially all of the limitations except for the adapter and tube being constructed of a clear plastic. However, Wilson does teach the use of clear plastic for internal viewing of the device when in use. Therefore, it would be obvious to one of ordinary skill in the art to modify the plastic of Coates to a clear plastic so that the device can be viewed internally during use.

16. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Wilson (US 4103502) further in view of Rosenblatt (US 4950247).

17. **As to claim 8**, the combination of Coates and Wilson teach essentially all of the limitations except for wherein the self-sealing member is siliconized. However, Rosenblatt does teach the use of silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

18. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Coates et al (US 5762063) in view of Rosenblatt (US 4950247).

19. **As to claim 9**, Coates teaches essentially all of the limitations except for wherein the self-sealing member is siliconized. However, Rosenblatt does teach the use of

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silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

Double Patenting

20. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

21. Claims 3 and 10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patented claims which are more specific embodiment anticipate the application claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

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22. Claims 4 and 11 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217 in view of Wilson (US 4106502). US Patent 6062217 to Gray teaches essentially all of the limitations except for wherein the adapter and tube are made of a rigid clear plastic. However, Wilson does teach the use of rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Therefore, it would be obvious to one of ordinary skill in the art to make the adapter and tube of Gray from a rigid clear plastic for compact size, economical cost of fabrication, and internal visibility.

23. Claims 5 and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6062217 in view of Wilson (US 4106502) and further in view of Rosenblatt. US Patent 6062217 to Gray teaches essentially all of the limitations except for wherein the adapter and tube are made of a rigid clear plastic. However, Wilson does teach the use of rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Therefore, it would be obvious to one of ordinary skill in the art to make the adapter and tube of Gray from a rigid clear plastic for compact size, economical cost of fabrication, and internal visibility. Also, Gray fails to specifically teach the self-sealing member being siliconized. However, Rosenblatt does teach the use of silicon since it is a material that has memory so that any element formed from silicon would return to its original shape if that element is deformed without requiring the use of a spring or other elastic material to bring the element back to its original shape. Therefore, it would be

obvious to one of ordinary skill in the art to make the self-sealing member of Coates from silicon so that it can return to its original shape after being deformed.

Conclusion

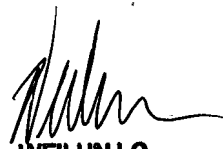
24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6427687, US 6318368, US 6123075, US 6058933, US 5996579, US 5803074, and US 5427091 .

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4520 for regular communications and 703-306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

mbp
February 9, 2003


WEILUN LO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700